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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,027	10/21/2003	John Hurd	005127.00348	4984

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WASHINGTON, DC 20001

EXAMINER

PATTERSON, MARIE D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Taka

<b>Office Action Summary</b>	<b>Application No.</b> 10/691,027	<b>Applicant(s)</b> HURD ET AL	
	<b>Examiner</b> Marie Patterson	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
    a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 112***

1. Claims 1-33, 38, and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 15 the phrase "wherein the arm moves..." and claims 10, 14, 27, and 33 in their entirety are functional, indefinite, and incomplete because they contain functional language not supported by recitation in the claim of sufficient structure to warrant the presence of such language. (MPEP 2114) It is not clear what structural limitations applicant intends to encompass with such language. Some of the above noted language appears to claim the element at two different points in time which is not proper in article claims and renders the claims vague and indefinite.

In claim 19 the phrase "are relatively positioned so as to define a space for receiving a user's toes" is vague and indefinite because it is not clear what structural limitations applicant intends to encompass with such language.

Claims 38 and 40 do not recite any additional method steps and therefore it is not clear what steps applicant intends to encompass.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-6, 9-18, 20, 21, 23, 26-29, 32-35, and 37-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogle (5282327).

Ogle shows a spring member (16 and 36), an arm (12/16), and a heel retaining element (14) and the inherent method of use as shown in the figures as claimed.

4. Claims 1-6, 9-13, 15-18, 20, 21, 23, 26-29, 32, 34, 35, and 38-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Dorr (2069752).

Dorr shows a spring member (28 and 29), an arm (21 and 24), and a heel retaining element (17) and the inherent method of use as shown in the figures as claimed.

5. Claims 1-7, 9-13, 15-18, 20, 21, 23, 24, 26-30, 32, 34, 35, 37, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Balut (2693039).

Balut shows a spring member (28) with a hole (center of spiral form), an arm (side portions of elements 26), a heel retaining element (top of elements 26), an interface (24), a footbed (18), and a midsole (12) and the inherent method of use as shown in the figures as claimed.

6. Claims 1-6, 9-12, 15-23, 26-29, 34-37, and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Neiley (2002/0174568).

Neiley shows a spring member (shown in figure 6) with an arm (front and rear portions), a heel retaining element (at 66), a toe retaining element (at 96 and/or 97) and the inherent method of use as shown in the figures as claimed.

7. Claims 1-3, 5, 6, 9, 10, 15-17, 20, 23, 26-29, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller (2746178).

Miller shows a spring member (figures 4 and 7), an arm (21 and 24), an outsole (21a) and midsole (20) as shown in the figures as claimed.

#### ***Allowable Subject Matter***

8. Claims 8 and 25 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

9. Applicant's arguments filed 6/24/05 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the 112 rejections, the fact that the arm is claimed as being connected to the spring member does not provide any structure or means which performs the function of the arm moving as claimed in the claims. If applicant is willing to state and agree that all arms which extend from spring member are capable of performing the recited function, then the structure claimed would be considered to be sufficient for the functional recitation. Since the examiner

assumed that applicant was attempting to provide some type of limitation by the functional recitation the Examiner considered that the functional recitation had not been supported by recitation of structures in the claim and therefore it is not clear what structural limitations applicant is intending to encompass by the functional recitation. Applicant appears to be attempting to claim the element at two different points in time, this is not proper and renders the claims confusing, vague, and indefinite. There must be some structure which performs the functions recited or at least recitation of a "means" which allows a function to occur. The claims currently do not recite such. In reference to applicants' arguments directed towards claims 14 and 33, these claims do not recite any structures and/or structural limitations and furthermore it is not clear what property or arrangement would be considered to be "stable". The claims are vague and indefinite because it is not clear what structural limitations applicant intends to encompass with the language of the claim. The claim language should be specific and clear and definite, not vague and indefinite.

In response to applicants' arguments directed towards Ogle, Ogle clearly shows a "bimodal spring", in that the spring member (16/36) is a spring which has two modes, one which is a stable open position shown in figure 1 and 5 and a second stable position shown in figure 2 and 6. The positions are stable in both positions without the external force of the foot, that is why element 20 is need to release the second stable position.

10. In response to applicants' arguments directed towards Dorr, Dorr clearly shows a "bimodal spring", in that the spring member (28 and 29) is a spring which has two

modes, one which is a stable position shown in figure 1 and a second stable position shown in figure 2. Absent any further structural limitations, claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974).

In response to Applicant's argument that Ogle, Dorr, Balut, Neiley, and/or Miller does not include certain features of Applicant's invention, the claims merely recite a bimodal spring and the spring elements shown and noted in the above rejections clearly are shown in the drawings of the Patents to be capable of being in two separate stable positions/modes which is all that is required of the claims and the positively recited structures are shown by the prior art as noted above. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. Constant v. Advanced Micro-Devices Inc., 7 USPQ2d 1064. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (572)272-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.



Marie Patterson  
Primary Examiner  
Art Unit 3728